

REMARKS

Claims 10, 11, 13-15, 18-22, 25-29, 31-32, 34-38, 46-59, and 61-64 are presented for reconsideration and allowance, after the amendment of claims 10, 14, 25, 46, 47, 52, and 53.

Claim form

On page 3 of the Office Action of June 18, 2004, the Office raised a new objection of claim 17 as being of improper dependent form. Applicants have canceled claim 17, thus obviating this objection. Accordingly, Applicants request that the objection be withdrawn.

Obviousness-type double-patenting

On page 4 of the Office Action, the Office maintained the rejection of claims 10-15, 17-22, 25-32, 34-38, 46-59 and 61-62 under the judicially created doctrine of obviousness-type double-patenting in light of the claims of application 09/973,013. The Office also indicated the "[t]he instant rejection will only be withdrawn when the instant claims are in condition for allowance and none of the cited claims in the copending application have been allowed." Because the claims of application 09/973,013 have not yet been allowed, Applicants have not filed a Terminal Disclaimer. Applicants respectfully request that the rejection be withdrawn after consideration of the amendments herein, which put the pending claims in condition for allowance.

35 U.S.C. § 112, second paragraph

On page 5 of the Office Action, the Office maintained the rejection of claims 14 and 27 because it found the phrase "chosen from adenylate cyclase or guanylate cyclase and a modulating substance" to be vague and indefinite. The Office asserted

that it is unclear “whether the modulating substance is a mandatory component of the first fragment or merely one of the possible options for the first fragment.”

Applicants have amended claims 14 and 27 to recite “wherein the first chimeric polypeptide in (A) comprises a fragment of adenylate cyclase or guanylate cyclase and the second chimeric polypeptide in (B) comprises a modulating substance.” Applicants respectfully assert that this amendment renders the claim definite and clear and that, therefore, the rejection should be withdrawn.

On page 5, the Office rejected claims 10 and 25 as being vague and indefinite because it asserted that the phrase “wherein the signal triggers transcriptional activation and expression of a reporter gene” is unclear. The Office asked whether it “[i]s the ‘transcriptional activation’ of the reporter gene that in turns leads to its expression or is said ‘transcriptional activation’ not directly related to the expression of the reporter gene?” As amended claims 10 and 25 recite that “the signal triggers transcriptional activation which leads to expression of a reporter gene” Therefore, the relationship between transcriptional activation and gene expression is clear, and Applicants respectfully request that the rejection be withdrawn.

On page 6, the Office rejected claims 46-47 and 52-53 because it found that the term “encoding a protein involved in the catabolism of a nutritional marker” is vague and indefinite. Applicants have amended the term to “encoding a protein for the synthesis of a nutritional marker” in claims 46 and 52. Similarly, Applicants have amended claims 47 and 53 to recite a “protein for the synthesis of a nutritional marker and the nutritional marker is lactose or maltose.” Because these claim terms are clear, Applicants respectfully request that the rejection be withdrawn.

35 U.S.C. § 112, first paragraph

On page 6 of the Office Action, the Office rejected claims 46-57 because it asserted that the term “encoding a protein involved in the catabolism of a nutritional marker”, which appears in claims 46-47 and 52-53, introduces new matter into the application. As explained above, Applicants have amended claims 46 and 52 to recite “encoding a protein for the synthesis of a nutritional marker” and claims 47 and 53 to recite “a protein for the synthesis of a nutritional marker and the nutritional marker is lactose or maltose.” These terms are supported on page 17, line 33, through page 18, line 1, and do not add new matter. Accordingly, Applicants respectfully request that the rejection be withdrawn.

On pages 7-9 of the Office Action, the Office rejected claims 46-47 and 52-53 under 35 U.S.C. § 112, first paragraph, because it asserted that they do not comply with the written description requirement. Specifically, the Office asserted that the claims are drawn to “a vast genus of gene fragments” and that these fragments are not described in the specification. Merely to further prosecution, Applicants have canceled the term “and a fragment of any of these genes.” Therefore, Applicants respectfully request that the rejection be withdrawn.

Applicants respectfully request that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing claims 10, 11, 13-15, 18-22, 25-29, 31, 32, 34-38, 46-59, and 61-64 in condition for allowance. Applicants submit that the proposed amendments of claims 10, 25, 46, 47, 52, and 53 do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, since all of the elements and their relationships claimed were either earlier claimed or inherent in the

claims as examined. Applicants request the entry of this Amendment, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: September 14, 2004

By: 
Deborah Katz
Reg. No. 51,863
Phone: (202) 408-4382
Fax: (202) 408-4400
E-mail: deborah.katz@finnegan.com